

IN THE
UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

Vol. 3467
See
JUN 11 1969

EDOCO TECHNICAL PRODUCTS, INC.,

Plaintiff-Appellant,

vs.

PETER KIEWIT SONS' CO., and
THE B. F. GOODRICH COMPANY,

Defendants-Appellees.

PETITION FOR REHEARING AND
SUGGESTION FOR REHEARING IN BANC
FILED BY PETITIONER
EDOCO TECHNICAL PRODUCTS, INC.

FULWIDER PATTON RIEBER LEE & UTECHT
FRANCIS A. UTECHT
920 Fidelity Federal Plaza
555 East Ocean Boulevard
Long Beach, California 90802

Attorneys for Petitioner

FILED

JUN 10 1969

WAL. B. LUCK, CLERK

SUGGESTION FOR REHEARING IN BANC

Pursuant to Rule 35(b) Federal Rules of Appellant Procedure petitioner suggests the appropriateness of rehearing this matter in banc. A reversal of the decision of May 28, 1969 is necessary to maintain uniformity with the decision of this Court in International Manufacturing Co. v. Landon, 336 F.2d 723 (August, 1964). In International this Court held that in a patent infringement case a file wrapper estoppel requires that the narrowed patent claim element goes to the heart of the invention. It will be apparent from the accompanying petition for rehearing that the panel of this Court that heard this matter failed to apply this doctrine.

PLAINTIFF-APPELLANT'S PETITION FOR REHEARING

The panel of this Court in rendering its decision of May 28, 1969 made a clear and simple mistake of fact of such magnitude that the panel could not help but err in applying the law regarding file wrapper estoppel.

The panel's mistake of fact appears at the very beginning of its decision of May 28, 1969 and is embodied in the following language:

"The patented device relates to paving and is designed to control the cracking of pavement as it contracts on drying and to seal the cracks against the seepage of water. The device is a resilient strip that is, along the desired line of fracture, embedded in the pavement while it is being poured. In its cross section it is cruciform, the vertical arms tapering from the center to top and bottom and the horizontal arms being serrated. The top vertical arm provides a continuing band running close below the pavement surface which causes fracturing in alignment with it. The horizontal arms provide water stops so that water seeping through the fracture cannot penetrate to work erosion beneath the pavement. The serrations serve to anchor the strip to the cement on either side."

As indicated by the above language the panel considered the patented invention to be the plastic strip per se. In fact, however, the patented invention is not the strip per se, but is a weakened plane joint in a paving section. This fact becomes immediately apparent from patent Claim 1, since it is axiomatic that the invention of a patent is set forth in its claims.

"Claim 1. In a paving section, a weakened plane joint, comprising: an elongated vertically extending paving fracturing band of lesser height than the depth of said paving section, said band having its upper portion tapering upwardly for a distance greater than the thickness of said band to provide a continuous straight edge below the upper surface of said paving section, said band having its lower portion tapering downwardly for a distance greater than the thickness of said band to provide a continuous straight edge disposed above the lower surface of said paving section whereby said paving section undergoes fracturing in vertical alignment with the upper and lower edges of said band as said paving cures so as to define said weakened plane joint across said paving section; and a horizontally extending sealing strip integrally

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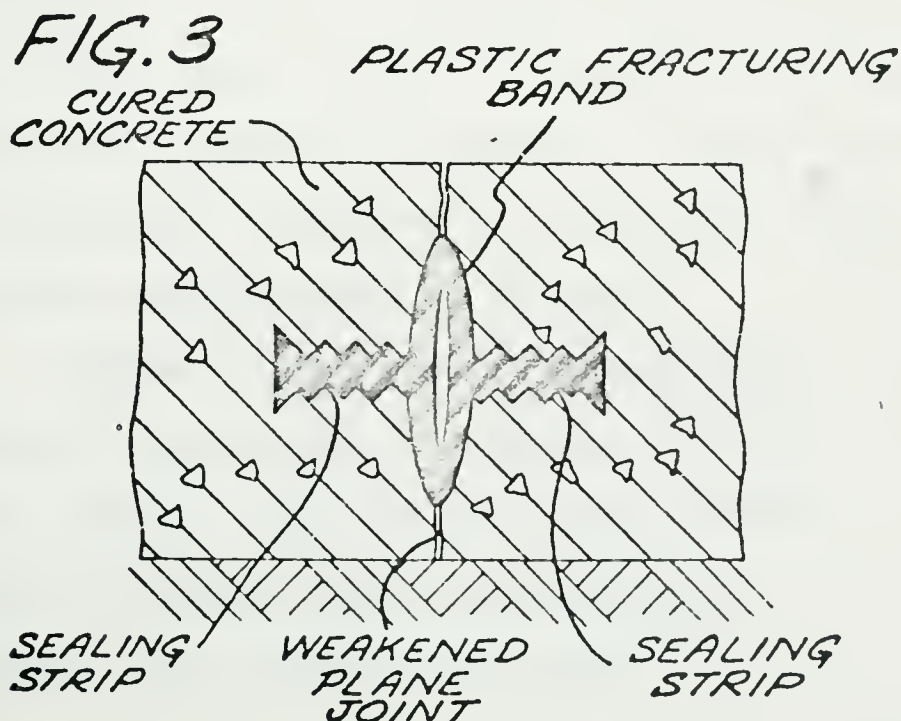
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connected to each side of said band, said strips each being formed with longitudinally extending serration means that are firmly embedded within said paving as said paving cures, said sealing strips cooperating with the paving section on either side of said weakened plane joint to restrain the downward flow of water through said joint, said paving fracturing band and said sealing strips being formed of resilient material whereby relative movement is permitted between the portions of said paving section on either side of said weakened plane joint."

The invention as recited in Claim 1 is shown at Page 6 of Plaintiff-Appellant's Opening Brief reproduced immediately herebelow:



CONTENTS
ORIGINAL ARTICLES
The Effect of the Diet on the Blood Sugar in Diabetes Mellitus
The Effect of the Diet on the Blood Sugar in Diabetes Mellitus

THE JOURNAL OF THE AMERICAN MEDICAL ASSOCIATION
PUBLISHED WEEKLY
CHICAGO, ILL., MAY 1, 1919
Vol. 34, No. 19

CONTENTS
ORIGINAL ARTICLES
The Effect of the Diet on the Blood Sugar in Diabetes Mellitus
The Effect of the Diet on the Blood Sugar in Diabetes Mellitus

THE JOURNAL OF THE AMERICAN MEDICAL ASSOCIATION
PUBLISHED WEEKLY
CHICAGO, ILL., MAY 1, 1919
Vol. 34, No. 19

CONTENTS
ORIGINAL ARTICLES
The Effect of the Diet on the Blood Sugar in Diabetes Mellitus
The Effect of the Diet on the Blood Sugar in Diabetes Mellitus

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PUBLISHED WEEKLY
CHICAGO, ILL., MAY 1, 1919
Vol. 34, No. 19

CONTENTS
ORIGINAL ARTICLES
The Effect of the Diet on the Blood Sugar in Diabetes Mellitus
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CONTENTS
ORIGINAL ARTICLES
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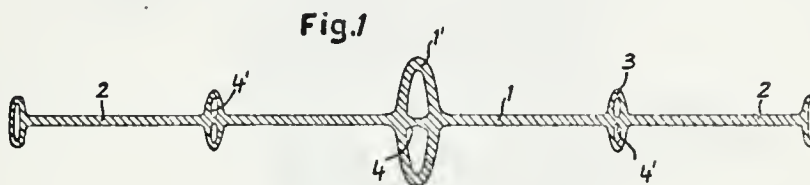
CONTENTS
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CONTENTS
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Taking the above drawing in conjunction with Claim 1 it will be apparent that the plastic strip (or band) per se is a complete nullity outside the completed weakened plane paving joint! Indeed, plastic strips used in paving joints having the same general shape of the plastic strip element of the patented combination were old in the prior art as represented by patents such as Wey Patent No. 2,901,904 appearing at Page 4 of PLAINTIFF-APPELLANT'S REPLY BRIEF and reproduced herebelow:

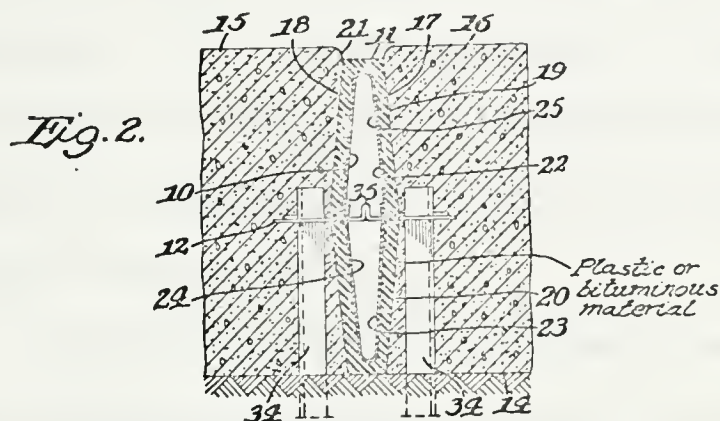


Wey Patent No. 2,901,904

Once the panel made the mistake of assuming that the patented invention was the plastic strip per se it was inevitable that such panel would err in applying the law regarding file wrapper estoppel. Thus, the panel after deciding the invention resided solely in the plastic band concluded that since the patent application claims did not initially recite the strip as being tapered, while the claims of the patent as issued included such tapering language, the tapering language was added to overcome a rejection on prior art. This conclusion of the panel was expressed as follows:

- "Modest as the taper's contribution may be to prior art, it appears from the file wrapper to be the only contribution
- that the Patent Office was willing to concede that appellant had made."

As noted hereabove the taper could not possibly be a contribution to the prior art since such tapers were old in the prior art. The Patent Examiner was well aware of this fact since he had before him Jacobson Patent No. 2,025,209 appearing at Page 4 of Plaintiff-Appellant's Reply Brief and appearing below. Jacobson shows a vertically tapered band in a pavement joint.

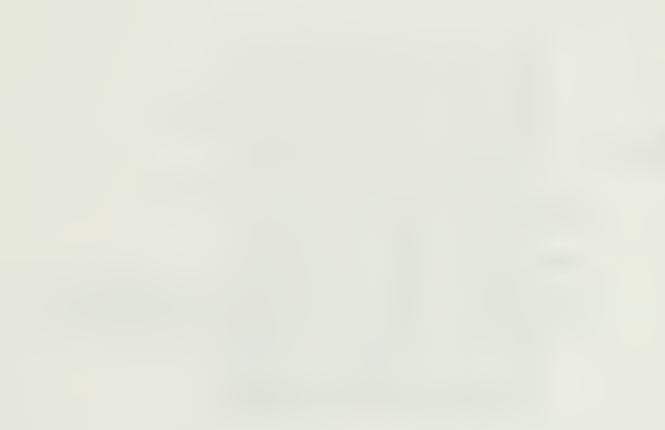


Jacobson Patent No. 2,025,209

Actually, what was new and what was patented was the combination of a length of paving in which a cruciform plastic strip was embedded in the paving so that its vertical element fractured the paving as the paving cured, while its horizontal element served as a flexible waterstop in the completed weakened plane joint. This concept was completely new and was the real contribution made by appellant to the art of paving.

If the panel had not made its critical mistake of fact, the panel would have applied the law of file wrapper estoppel set forth by this Court in International Manufacturing Co. v. Landon 336 F.2d 723 (August, 1964). In International, this Court stated that file wrapper estoppel does not occur unless a claim is modified to obtain its allowance in such a manner as to go to the heart of the invention. Thus, this

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Court stated:

"The gravamen of file wrapper estoppel, as this Court recently said in *M.O.S. Corp. v. John I. Haas Co.*, 9 Cir., 332 F.2d 910, 141 USPQ 767, is that an applicant who acquiesces in the rejection of his claim, and accordingly modifies it to secure its allowance, will not subsequently be allowed to expand his claim by interpretation to include the principles originally rejected, or their equivalents.

As indicated by the statement made by the examiner at the time, claim 10 was not rejected because of an overly-broad definition of filter elements, or because it permitted use of a sock-type filter. It was rejected for the reason that claim 10, read as a whole, was unpatentable over other named patents. The disc-like filter element could not be the heart of the Pace invention since it, as well as the sock-type filter element, is old in the art. What was new, and what was patented, was the combination of parts in which a filter unit is correlated to the remaining elements so that the combination performs the desired skimming and filtering functions." (Emphasis Added.)



Because the International Manufacturing Co. case is on all fours with the present case, a brief examination of the facts in International is believed necessary. In International the patented combination was a water recirculation system for use in swimming pools and included a filter, a filter housing, a water passage, a screen, a buoyant weir and a pump. The questioned patent claim originally recited the filter in broad terms. During the patent prosecution the definition of the filter was narrowed to recite such filter as being disc-like. The infringer's device utilized a sock-type filter. It was the infringer's contention that since the patent claim originally recited the filter in broad terms and was later narrowed to recite the filter as being disc-like, a file wrapper estoppel existed against construing the claim broadly enough to read upon the infringer's sock-type filter.

As indicated by the above language, this Court in International rejected such contention on the basis that the disc-like filter could not be the heart of the invention since it was old in the art, and that what was new and what was patented was the combination of parts in which a filter unit of any type was correlated to the other elements of the combination so that the combination performed the desired function.

From the above review of the International case, it will be seen that the present case is exactly apposite. In the present case the patent claims did not initially recite the vertical band as being tapered. During the prosecution



of the application, however, the tapering of the vertical band was added to the claims. How could such tapering possibly be considered the heart of the invention in view of the fact that vertically tapered bands were old in the art, as represented by the aforementioned Wey and Jacobson patents?

As noted at Page 35 of Plaintiff-Applicant's Opening Brief, the tapering language was added to the claims in conjunction with newly-presented functional language to revise the form of the claims and thereby better distinguish the principle of operation of the entire combination over the cited British patent.

What was actually new and what was actually patented by appellant is set forth in the patent claims. These patent claims clearly recite a weakened plane joint comprising a length of paving and a generally cruciform resilient strip wherein the vertical band of the strip is correlated with the paving so that it effects the vertical fracture of the weakened plane joint and the horizontal band of the strip provides a flexible waterstop between the paving at the sides of the completed joint. A weakened plane joint of this description was completely new in the paving art, was a great commercial success, and was copied by the defendants.

From the foregoing argument it will be clear that the decision of the panel cries out for a rehearing. Moreover, since the panel found that the accused device "is similar in function and very similar in appearance" and "performs the identical function in substantially the same manner as does the

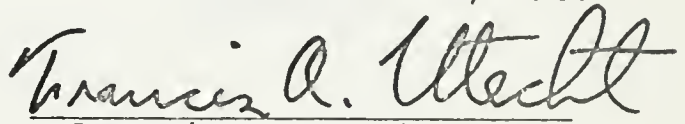


patented device," it will also be clear that the accused device infringes. Petitioner therefor prays for a rehearing and reconsideration and ultimately a reversal of the Summary Judgment. Such reversal will result in uniformity with the law in this Circuit as exemplified by the International case.

Respectfully submitted,

FULWIDER PATTON RIEBER LEE & UTECHT

By Francis A. Utecht
Attorneys for Petitioner,
Edoco Technical Products, Inc.


Francis A. Utecht



See Vol. 34-70

JUL 15 1969

UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

FILED

SODERHAMN MACHINE MANUFACTURING
COMPANY,

Appellant,

vs.

THE MARTIN BROS. CONTAINER &
TIMBER PRODUCTS CORP.,

Appellee.

JUL 15 1969

WM. B. LUCK, CLERK
NO. 22281

APPELLEE'S PETITION FOR
REHEARING

Pursuant to Rule 40, Federal Rules of Appellate Procedure, Defendant-Appellee respectfully petitions the Court for rehearing with respect to and involving the items in the Court's Opinion of July 2, 1969, hereinafter set forth.

1. Barker Foundation Structure

The barker foundation structure was the structure holding the barker, as distinguished from the machine itself. The Court may have been misled by the heading in Invoice D 1141 "Repair to Barker", but the items detailed on the invoice refer unmistakably to the barker structure. Soderhamn concedes this so far as some items are detailed, and concedes that the witness, Halverson, gave testimony that this invoice

was properly chargeable to the barker structure (Brief p. 32). This Court has eliminated entirely the sum of \$3,084.32 represented by this invoice. The item should be restored.

2. Kicker, Kicker Shafts and Kicker Arms

This Court affirmed the District Court in the finding that the kicker system was defective. The District Court had before it in finding the damage, as a part of Exhibit 921-A through 921-N (which had been received in evidence, Tr. p. 356) Invoices D 1559, D 1615, D 1368, D 1368-A, D 1306, D 1306-A, D 1365 and D 1241, and included them in determining Martin's damage. The record clearly shows that these invoices had been received in evidence (Tr. 356) and also that the supporting data for these invoices had been received in evidence as Exhibit No. 931 (Tr. 187). This Court mistakenly stated that the invoices were not introduced in evidence and that Martin offered in evidence only invoice summaries which the District Court ordered stricken from the record, and consequently modified the District Court's findings by reducing the damage to \$35.00. The exhibit referred to as a summary, entitled "Survey of condition existing and remedial work performed to place same in operable condition" was offered only as an aid to the court, and was withdrawn (Tr. 351) only because a copy was attached



to and a part of Exhibit 921 A through N, already in evidence. This reduced item of damage should be restored.

3. Sheer Aprons

This Court affirmed the trial court in its finding that the sheer aprons were necessary to the unit as conceived in the contract. This Court disallowed the cost of correction in the amount of \$2,758.16 for the stated reason that the witness for Martin testified from summaries of invoices which were stricken from the record by the District Court.

The basic information from which the witness Halverson testified was contained in the exhibits and supporting business records, all of which were received in evidence as were the summaries which were offered for the convenience of the Court, all as set forth in the foregoing subject No. 2 relative to Kickers. This item should be restored.

4. Hog Conveyor

This Court sustained the District Court's finding that the hog conveyor installed by Soderhamn was insufficient and it was necessary to redesign and reinstall the conveyor. This Court further found that there was no competent evidence to support the award of \$14,063.02 for the necessary correction of this deficiency.



The Court cited as its authority for disallowing the necessary cost the fact that the evidence offered was summaries and that these were stricken from the record. Again, the basic evidence was contained in the invoice Exhibits 921-A through 921-N and were received in evidence and the basic business records in support thereof were also in Court and were received in evidence and were available to the Court and the evidence as to cost was supported by these exhibits as well as the testimony of Mr. Halverson.

In addition Soderhamn offered evidence that the reasonable cost of cure for the hog conveyor was less than the \$14,063.02, one of Soderhamn's witnesses putting reasonable cost at \$3,000 to \$5,000 (Tr. 1778) and another Soderhamn witness, Mr. Wahl, at \$5,970 (Tr. 1688). There was evidence to sustain damages and the items allowed by the District Court should be restored.

5. Prejudgment Interest

The Court allowed prejudgment interest on two items aggregating \$1,018.40, the amounts being ascertainable by simple computation and a time of definite default being ascertainable. The Court also affirmed the trial Court in a determination that Soderhamn had failed to furnish a debarking machine, or barker, for which Soderhamn had received \$81,500.00 of Martin's money. The Opinion states "The District Court properly held that Martin was entitled to a



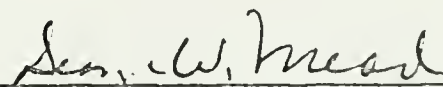
refund or abatement of the purchase price of the machine". A note in the opinion refers to a sale by Soderhamn to some third party, which the pre-trial order shows followed removal of the barker from the Martin plant on November 13, 1963, from which date Soderhamn claimed interest. Interest on this refund to which Martin was entitled in the sum of \$81,500.00 from January 1, 1964, as allowed by the trial court, should be restored.

WHEREFORE, Defendant-Appellee, Martin, prays that this Court grant a rehearing with respect to the foregoing matters, or in the alternative, modify its opinion and judgment by restoring the items of damage as found by the District Court and restoring the pre-judgment interest on \$81,500, the price of the barker.

Respectfully submitted,



Irving Rand



George W. Mead
1211 Public Service Building
Portland, Oregon 97204

Attorneys for Defendant-
Appellee

Due service of the within Appellee's Petition for Rehearing is hereby accepted in Multnomah County, Oregon, this 14th day of July, 1969, by receiving a copy thereof, duly certified to as such by George W. Mead, of Attorneys for Defendant-Appellee.

Sd. Jack H. Dunn

Of Attorneys for Plaintiff-
Appellant

I hereby certify that I have prepared the foregoing copy of Appellee's Petition for Rehearing and have carefully compared the same with the original thereof; and that it is a correct copy therefrom and of the whole thereof.

Dated this 14th day of July, 1969.



George W. Mead
Of Attorneys for Appellee

